

DOCKET NO.: 294145US8PCT/dgg

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF:

GROUP: 2166

Yuichiro TO

SERIAL NO: 10/589,638

EXAMINER: Wong, J.

FILED: August 16, 2006

FOR: CONTENT TRANSFER APPARATUS AND ASSOCIATED  
METHODOLOGY OF UPDATING CONTENTS BETWEEN DEVICES

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

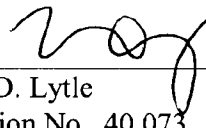
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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REMARKS ACCOMPANYING

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant respectfully requests that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005, and extended in the Official Gazette Notice of February 7, 2006.

REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Office Action dated April 16, 2009, (hereinafter "Office Action") rejected independent Claim 15 under 35 U.S.C. § 112, second paragraph, as directed to a product and a process. The Advisory Action dated July 2, 2009, (hereinafter "Advisory Action") neither indicated this rejection as having been overcome by the Request for Reconsideration filed June 15, 2009, (hereinafter "Request for Reconsideration") nor did it provide an explanation supporting the maintenance of the rejection.

Claim 15 is directed to “A computer-readable, tangible, storage medium including a computer program, wherein the program . . . causes the computer to execute a procedure . . . .” As noted at page 3 of the Request for Reconsideration, the procedure recited in Claim 15 is not a procedure for using the claimed storage medium. It is thus submitted that Claim 15 is not directed to both a product *and* a process of its use.

Further, the Office Action advanced the position that Claim 15 lacks the formality of a tangible storage medium.<sup>1</sup> In this regard, Applicant reiterates that Claim 15 claims “A computer-readable, *tangible, storage medium* . . . .” If this position is to be maintained, Applicant respectfully requests further clarification, according with page 4 of the Request for Reconsideration.

It is respectfully requested that the rejection of Claim 15 under 35 U.S.C. §112, second paragraph, be withdrawn.

#### REJECTION UNDER 35 U.S.C. § 102

Applicant submits that the Office Action and the Advisory Action have failed to establish a *prima facie* case of anticipation, because Goodman et al. (U.S. Patent No. 6,928,433 B2, hereinafter “Goodman”) fails to teach every element recited in independent Claims 1, 8, and 15.

Claim 1 recites an information processing apparatus, including, in part,

a memory configured to store contents; and

a data processor configured to transfer said contents to an external device;

wherein said data processor is configured to acquire recorded data including content IDs about the contents already transferred from said information processing apparatus to said external device connected to said information processing apparatus, and said data processor being further configured to

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<sup>1</sup> Office Action at 4, ll. 20-21.

compare the acquired recorded data about the transferred contents with the content IDs of said contents . . . .

Applicant respectfully submits that Goodman fails to disclose or suggest those features.

Goodman concerns a “user interface for a small portable music player . . . .”<sup>2</sup>

According to Goodman, when the portable music player “is coupled to host system 302, a user of host system 302 can launch a bridge interface to allow for the transfer of files between [the portable music player] and host system 302.”<sup>3</sup>

As previously detailed at page 5 of the Request for Reconsideration and pages 10-11 of the Amendment filed February 11, 2009, Goodman merely describes transferring files between the portable music player and the host system. Goodman is silent with regard to a comparison of content IDs of those files. Thus, Applicant submits that Goodman fails to disclose or suggest “a data processor configured to transfer said contents to an external device,” “said data processor being further configured to compare . . . acquired recorded data about the transferred contents with” “content IDs about the contents already transferred from said information processing apparatus to said external device connected to said information processing apparatus,” as recited in Claim 1.

The Office has previously labeled similar arguments as “spurious”<sup>4</sup> and “inapplicable.”<sup>5</sup> However, because the Office has not addressed those arguments on the merits,<sup>6</sup> Applicant respectfully requests that the Office clearly develop the ground on which the above-noted feature is rejected prior to appeal of that ground to the Board of Patent Appeals and Interferences.

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<sup>2</sup> Goodman, col. 2, ll. 6-7.

<sup>3</sup> Id., col. 11, ll. 29-31.

<sup>4</sup> Advisory Action at 2, ll. 3-4.

<sup>5</sup> Office Action at 3, ll. 14-15.

<sup>6</sup> See, e.g., id.

Further, the Office has cited to Goodman for its “search retrieval queries to populate playlist with Fig. 8 . . . .”<sup>7</sup> To buttress its position that Goodman inherently discloses Applicant’s recited data processor, the Office stated that “a play list and search retrieval query to populate playlist necessarily and always involves comparison.”<sup>8</sup>

Even assuming *arguendo* that such search retrieval queries involve some unidentified comparison, such queries are not necessarily based on content IDs of transferred files, as more fully developed at page 5 of the Request for Reconsideration. Thus, Goodman does inherently disclose or suggest a comparison of “acquired recorded data about the transferred contents with the content IDs of said contents stored in said memory,” as recited in Claim 1.

Applicant submits that independent Claim 1 (and all associated dependent claims) patentably defines over Goodman. It is further submitted that independent Claims 8 and 15 (and all associated dependent claims) are allowable for the same reasons as discussed above with regard to Claim 1 and for the more detailed features presented in those claims.

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<sup>7</sup> Office Action at 4, ll. 2-3.

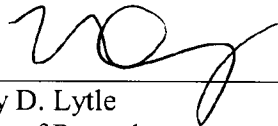
<sup>8</sup> Advisory Action at 2, l. 12.

CONCLUSION

Based on the above-noted deficiencies in the Office Action and the Advisory Action, Applicant respectfully requests that prosecution be re-opened as the current grounds of rejection have not clearly been developed to such an extent that the Applicant can readily judge the advisability of preparing a traditional Appeal Brief.

Respectfully submitted,

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